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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,456	11/13/2003	Lawrence G. Hamann	LA0091 NP	9300

23914 7590 05/31/2007
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EXAMINER

BALASUBRAMANIAN, VENKATARAMAN

ART UNIT	PAPER NUMBER
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1624

MAIL DATE	DELIVERY MODE
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05/31/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/712,456

Applicant(s)

HAMANN ET AL.

Examiner

Venkataraman Balasubramanian

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 5 is/are rejected.
- 7) ☒ Claim(s) 3, 4 and 6-8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicants' response filed on 3/14/2007 is made of record. Claims 1 and 3-8 are pending. In view of applicants' response, all 112 second paragraph rejections made in the previous office action have been obviated. However, the following new grounds of rejections applied to currently pending claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Persons et al., WO 01/070684.

Persons et al., teaches several pyrrolidine compounds, which include instant compounds. See entire document especially see example 32 on page 83. Also see Figures 1 through 14 for various compounds, which include instant compounds. See Fig. 1, 4, 7, 10, 13, 20, 23, 26, 29, 32,, 34, 35,37, 40, 43, 46, 49, 56, 59,62, 65, 68, 70, 71, 73, 76, 79, 82, 85, 88, 92, 95, 98, 101, 104, 107, 128, 131, 134, 137, 140, 143, 167, 170, 173, 176 and 179. Note these compounds, given the broadest definition of the various variable definitions, meet the requirement of compounds generically embraced in claim 1.

Claims 1 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Halazy et al., EP 1125925.

Halazy et al., teaches several amine compounds, which include instant pyrrolidine compounds. See formula I on page 4 and note the definition of various groups. See pages 6-11 for various species, which include pyrrolidine carboxamide. See entire document especially Table I, for various compounds, which include instant compounds. See examples 7-11, 32-36, 59-61, 84-86, 103-107 and 120-124. Note these compounds, given the broadest definition of the various variable definitions, meet the requirement of compounds generically embraced in claim 1.

Claims 1 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Chalquest, WO 01/054498.

Chalquest teaches several substituted hydroxyproline compounds, which include instant pyrrolidine compounds. See page 3, formula I and note the definition of various groups. See formula 47 shown in Figure 12. See entire document especially Figure 1-99, for various compounds, which include instant compounds. See Figure 22, 23, 47-301 for various substituted hydroxy proline and the process of making. Note these compounds, given the broadest definition of the various variable definitions, meet the requirement of compounds generically embraced in claim 1.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Duan, WO 00/59874.

Duan teaches several substituted hydroxylamine compounds, which include instant pyrrolidine compounds as intermediates. See page 4, formula I and note the definition of various groups. See formula III shown in page 20. See entire document for

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various compounds, which include instant compounds. See examples 33 and 34, (Table 1, page 59) and note these compounds were made from the corresponding ester.

Claims 1 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Gabriel et al., US 2001/008901.

Gabriel et al., teaches several substituted proline compounds, which include instant compounds. See page 3, formula I and note the definition of various groups. See entire document for various compounds including species shown in page 4-8, which include instant compounds. See examples 5, 7, 9 and 10, (Table 1, pages 16-19) and note these compounds were made from the corresponding ester. Note these compounds, given the broadest definition of the various variable definitions, meet the requirement of compounds generically embraced in claim 1.

Claims 1 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Sekiyama et al., US 2002/0133004 (Equivalent WO 2001017980 published 3/15/2001).

Sekiyama et al., teaches several substituted proline compounds, which include instant compounds as intermediates. See page 2, compound 4 and page 5 compound 16. Also see examples 1-6. Note these compounds, given the broadest definition of the various variable definitions, meet the requirement of compounds generically embraced in claim 1.

Allowable Subject Matter

Claims 3, 4 and 6-8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Conclusion

Any inquiry concerning this communication from the examiner should be addressed to Venkataraman Balasubramanian (Bala) whose telephone number is (571) 272-0662. The examiner can normally be reached on Monday through Thursday from 8.00 AM to 6.00 PM. The Supervisory Patent Examiner (SPE) of the art unit 1624 is James O. Wilson, whose telephone number is 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned (571) 273-8300. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAG. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-2 17-9197 (toll-free).


Venkataraman Balasubramanian

5/29/2007